

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following remarks is respectfully requested.

Claims 18 and 20 are presently active in this case and have been amended without the introduction of new matter to more accurately reflect the invention as described relative to the showing of FIG. 1, note page 9, line 26-page 11, line 9 of the specification, for example.

Claims 1-8 were previously canceled and Claims 15-17 and 19 are presently canceled without prejudice or disclaimer. Claims 11-14 have been withdrawn from consideration as being directed to a non-elected invention.

In the outstanding Official Action, unknown claims¹ were rejected under the second paragraph of 35 U.S.C. 112 and Claims 15-20 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Initially, it is noted that the outstanding Action has been improperly indicated to be “FINAL” on only the “Office Action Summary” and that the outstanding Action also lacks any indication of “A STATUTORY PERIOD FOR REPLY” on this “Office Action Summary” or in the body of this outstanding Action. While a telephone call to the Examiner on April 11, 2006, resulted in the Examiner indicating her intent that this Action was to be made “FINAL,” and that a 3-month shortened statutory period was intended to be set, the fact remains that the outstanding Official Action that was mailed was improper in failing to properly indicate such intent.

Not only does the outstanding Official Action fail to include a statement as to Action finality in the body of the Action, as well as fail to set any shortened statutory period for response, it also failed to follow MPEP § 706.07 (f). This section of the MPEP specifically

¹ The outstanding Action omitted the numbers of the claims being rejected on this ground.

notes that the notice "if the reply is filed within 2 months of the date of the final Office Action, the shortened statutory period will expire at 3 months from the date of the final rejection or on the date the advisory Action is mailed, whichever is later," must be included with any statement of Action finality.

Moreover, page 2 of the outstanding Action does not follow established requirements as to the rejection under the second paragraph of 35 U.S.C. § 112 that fails to indicate the numbers of the claims subject to this rejection. See MPEP § 706.01 as follows:

The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the examiner's action. (Emphasis added).

Accordingly, withdrawal of the improper outstanding Action is respectfully submitted to be in order along with entry of the present amendment.

In light of the several grounds for rejection, Claims 15-17 and 19 have been canceled and Claims 18 and 20 have been amended to clearly recite the structural components of this apparatus.

More precisely, independent Claim 18 has been amended to recite a product manufacturing cost-estimation apparatus including a three-dimensional CAD unit to more closely parallel the disclosure related to FIG. 1 and avoid any criticism that the claims are merely "narrative" or fail to conform to current U.S. practice. Accordingly, the rejection under the second paragraph of 35 U.S.C. § 112 is traversed as not being relevant to amended Claims 18 and 20.

If the PTO is to assert that Claims 18 and 20 are replete with grammatical and idiomatic errors to an extent that these claims cannot be understood when read in light of the disclosure, it is requested to enumerate such errors.

Turning to the rejection of Claims 15-20 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter, the cancellation of Claims 15-17 and 19 is submitted to render this rejection thereof moot.

With regard to Claims 18 and 20, it is noted that the subject matter there of is clearly a “machine.” As noted at page 2100-14 of MPEP § 2106 (IV)(B)(2)(a), “[a] *machine* is ‘a concrete thing, consisting of parts or of certain devices and combinations of devices.’” (Emphasis in original, citation omitted). As further noted in this section, “[i]f a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product.”

The outstanding Action acknowledges (at page 3, lines 1-2) that even the previously presented claims were all directed to an “invention implemented on a computer; therefore, the invention is directed to the technological arts.” As noted above, the subject matter of Claims 18 and 20 is not just in the “technological arts,” it is directed to subject matter defining a useful machine by identifying the physical structure thereof. See MPEP § 2106 (IV)(B)(2)(a), at 2100-15 as follows:

A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory. In most cases, a claim to a specific machine or manufacture will have a practical application in the technological arts. See *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (“the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an ‘abstract idea,’ but rather a specific machine to produce a useful, concrete, and tangible result.”); and *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601 (“the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’ - a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities

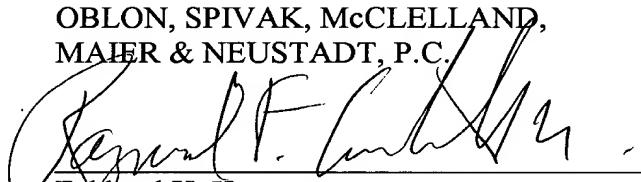
and in subsequent trades."). Also see *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.).

Consequently, for all the above-noted reasons, the rejection of Claims 18 and 20 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter is traversed.

As no other issues are believed to remain outstanding, the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)